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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,618	12/18/2000	James M. Barton	60097-0195	9889
29989 7590 05/15/2009 HICKMAN PALERMO TRUONG & BECKER, LLP 2055 GATEWAY PLACE SUITE 550 SAN JOSE, CA 95110				
			EXAMINER SHELEHEDA, JAMES R	
			ART UNIT 2424	PAPER NUMBER
			MAIL DATE 05/15/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/740,618

Applicant(s)

BARTON, JAMES M.

Examiner

JAMES SHELEHEDA

Art Unit

2424

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 16-32 and 37-41 is/are pending in the application.
- 4a) Of the above claim(s) 1, 4, 17, 19-31, 38 and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16, 18, 32, 37, 40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/3508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Election/Restrictions

1. Claims 1, 38 and 39 are withdrawn from consideration as being directed to a non-elected invention. The restriction requirement of 01/18/07, identified two separate sub-combinations usable together. One was directed to enhancing viewership during a *commercial break*, and the other was directed to individual *advertisements* with designated content portions (see applicant's specification at page 3, lines 9-19 and page 8, line 22-page 9, line 28).

The subject matter of claim 1, is directed to displaying a beginning portion of a commercial and allowing a viewer to watch or skip the individual. As this particular feature is performed by appending information into the beginning portion of *individual advertisements* (see applicant's specification at page 3, lines 9-19, page 8, line 22-page 9, line 28), it is withdrawn from consideration, as this is directed to the non-elected invention.

See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 32 and 37 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 32 recites "receiving...an introductory portion of a commercial break", "wherein the introductory portion of the commercial break comprises one of: a set of one or more images that introduces the commercial, or a multi-frame video that introduces the commercial" and "pausing playing of the program segment after displaying the introductory portion of the commercial break" which is not supported by applicant's specification as originally filed.

More specifically, applicant's specification disclose wherein the "introductory portion of a commercial break" may be a set of images or logos, a short sequence of animations **or** a menu (page 8, lines 22-28).

When the beginning of a commercial break is a menu, the system may pause the program after displaying the menu (page 9, lines 4-12).

There is no specific support however, for an introductory portion of a commercial *break*, which comprises one of: a set of one or more images that introduces a commercial, or a multi-frame video that introduces a commercial".

The introductory portion of a commercial **break** is only disclosed as either a menu which will pause the broadcast program *or* a set of images or logos or a short sequence of animations.

Response to Arguments

4. Applicant's arguments filed 09/15/08, regarding claim 16 been fully considered but they are not persuasive.

On page 14, applicant argues that Balakrishnan fails to disclose an "in band signal".

In response, Balakrishnan specifically discloses wherein the broadcast program includes packets representing a "mosaic picture" of hotspots representative of available commercials (column 3, lines 40-56). Applicant's arguments are not convincing, as this clearly constitutes an "in band signal".

In response to applicant's arguments on pages 16-17, it is noted that this claim is not supported by applicant's specification as originally filed.

While the claim calls for an "introductory portion of a commercial break", applicant's specification only discloses where the beginning portions of *individual commercials* may consist of "a set of one or more images that introduces the commercial, or a multi frame video that introduces the commercial" (page 9, lines 21-28).

The "introductory portion of a commercial break" which would include "pausing" as recited in the claim is only in regards to the display of a menu (page 9, lines 4-12).

There is no specific disclosure of this commercial break "menu" also including "a set of one or more images that introduces the commercial, or a multi frame video that introduces the commercial", as recited in the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16, 18, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Balakrishnan et al. (Balakrishnan) (6,473,903) (of record) in view of Haddad (6,072,982).

As to claim 16, while Balakrishnan discloses a process for enhancing viewership of television advertisements (column 3, lines 20-38), comprising:

receiving, by a digital video receiver, a program segment containing a commercial break (receiving a "main program"; Fig. 1; column 3, lines 20-38);

playing the program segment to a viewer (column 3, lines 20-38);

detecting, by the receiver, an in band signal, displaying, by the receiver, a menu as specified by the in band signal (menu to display ad logos; column 3, line 40-column 4, line 9);

wherein the viewer is allowed to select a particular item in the menu (column 3, line 66-column 4, line 9), he fails to specifically disclose pausing playback of the program segment, while displaying the menu.

In an analogous art, Haddad a television distribution system (Fig. 3) wherein the receiver will pause playback of the broadcast program whenever a menu is displayed on the screen (column 12, lines 44-56 and column 14, lines 15-26) until the viewer is finished browsing the menu selections (column 12, lines 44-56) for the typical benefit of ensuring that the viewer can browse and make a selection from the menu without missing any of the program (column 12, lines 44-56).

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Balakrishnan's system to include pausing playback of the program segment, while displaying the menu, as taught in combination with Haddad, for the typical benefit of allowing a viewer browse a menu as desired and return to the program without missing anything.

As to claim 18, Balakrishnan and Haddad disclose wherein the in band signal comprises a tag that triggers the DVR to display the menu and wherein the tag includes information to be displayed in the menu (Balakrishnan at column 3, lines 40-56 and Fig. 1).

As to claim 40, Balakrishnan and Haddad disclose wherein the pausing step is triggered by the DVR upon detection of an in band signal (see Balakrishnan at column

3, lines 40-56 and Fig. 1 and Haddad at column 12, lines 44-56 and column 14, lines 44-56).

As to claim 41, Balakrishnan and Haddad disclose wherein the menu includes information about each of the commercials to be displayed in the commercial break (Balakrishnan at column 3, lines 40-56 and Fig. 1),

creating, by the DVR, the menu based on the information about each of the commercials in the commercial break (Balakrishnan at column 3, lines 40-56 and Fig. 1).

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with

all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

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Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. () _____ - _____ on _____.
(Date)

Typed or printed name of person signing this certificate:

Signature: _____

Registration Number: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES SHELEHEDA whose telephone number is (571)272-7357. The examiner can normally be reached on Monday - Friday, 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Sheleheda/
Examiner, Art Unit 2424

JS